

### **REMARKS**

Claims 1-21, 31-40, 50, and 53-63 are pending in this application. Claims 1, 12, 31, 37, 50 and 53 are independent claims. In light of the remarks included herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner objected to the drawings and the specification. The Examiner further rejected claims 1-21, 31-40, 50 and 53-63 under 35 U.S.C. §112, first paragraph; and rejected claims 1-21, 31-40, 50 and 53-63 under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse these rejections.

### **DRAWINGS OBJECTION**

The Examiner objected to the drawings asserting newly added claim elements must be shown in the drawings. Applicants respectfully submit that the claim elements are properly depicted in the drawings.

With regard to “the position coding pattern codes an area of unique, continuous positions in two dimensions, the Examiner’s attention is respectfully directed to at least Fig. 7, which depicts a part of a product in the form of a sheet of paper A1, which on at least part of its surface A2 is provided with an optically readable position-coding pattern A3 which makes possible position determination. The position-coding pattern comprises marks A4, which are systematically arranged across the surface A2, so that it has a “patterned” appearance. The sheet of paper has an X-coordinate axis and a Y-coordinate axis (Specification, [0188]-[0189]). Absolute positions may be used on an imaginary surface which is made up of all the points or positions which can be coded by means of the position-coding pattern. Each position is defined by at least two coordinates (Specification, [0022]). As the positions are described using X and Y coordinates, clearly, this is sufficient to depict “the position coding pattern codes an area of unique, continuous positions in two dimensions.”

With regard to “said area is incapable of being encoded in its entirety by the position coding pattern on any single base,” the Examiner’s attention is respectfully directed at least to Fig. 2, which depicts a schematic diagram that shows a first imaginary surface with main regions that are dedicated to different purposes. The position-coding pattern covers a total surface which is imaginary in as much as it is very large and is therefore never present in its entirety on a base

[Specification, 0023]. As such, clearly this is sufficient to depict “said area is incapable of being encoded in its entirety by the position coding pattern on any single base.”

With regard to “the position coding pattern codes a second area of unique continuous positions,” the Examiner’s attention is respectfully directed at least to paragraph [0022] of the U.S. publication, which recites that if there are several imaginary surfaces, a third coordinate can be used to define which imaginary surface is in question. As such, clearly this is sufficient to depict “the position coding pattern codes a second area of unique continuous positions.”

In support of the Examiner’s objection, the Examiner recites “Notice, that Figure 5 discloses subregions 210-213 which are not continuous and has a particular size...” Applicants do not understand this statement. The claim elements objected to clearly refer to the coding pattern coding an area of unique and continuous **positions**. The Examiner’s reference to Fig. 5 and the purported discontinuous subregions appears to be wholly misplaced. If the Examiner maintains his objection to the drawings, Applicants respectfully request clarification as to the relevance of this citation so that Applicants may have the opportunity to properly respond.

### **SPECIFICATION OBJECTION**

The Examiner objected to the specification asserting newly added claim elements are not described in the specification. The Examiner’s attention is directed to the discussion above with regard the drawings. The Examiner is reminded that, as set forth in MPEP §608.01(o), an applicant is not limited to the nomenclature used in the application as filed. In addition, the second paragraph of MPEP § 2163.I.B indicates that the requirement for the specification to support added claim limitations is not an *in haec verba* requirement (i.e., the specification is not required to use the exact language in the claims). Instead, this section of the MPEP indicates that the specification may support added claim limitations through express, implicit, or inherent disclosure.

As there is sufficient disclosure for the claim elements, as noted above, Applicants respectfully request that the outstanding objection be withdrawn.

**CLAIM REJECTIONS – 35 U.S.C. §112, FIRST PARAGRAPH**

The Examiner rejected claims 1-12, 31-40, 50 and 53-63 asserting the newly introduced elements in the claims do not satisfy the written description requirement. Applicants respectfully disagree and direct the Examiner's attention to the discussion set forth above regarding the drawing objections.

In addition, Applicants note that MPEP § 2163 sets forth guidelines for the examination of patent applications under the "Written Description" requirement of 35 U.S.C. § 112, first paragraph. MPEP § 2163.II.A lists the methodology for the Examiner to follow in order to determine the adequacy of the Written Description. This methodology includes the following steps:

1. For each claim, determine what the claim as a whole covers;
2. Review the entire application to understand how Applicants provide support for the claimed invention including each element and/or step; and
3. Determine whether there is sufficient Written Description to inform a skilled artisan that Applicants were in possession of the claimed invention as a whole at the time the application was filed.

Applicants respectfully submit that the Examiner did not follow this methodology in rejecting the claims. Instead, it appears that the Examiner concluded that particular claim elements are not enabled because the exact language is not found in the specification. Applicants respectfully submit that such analysis is not permitted according to the aforementioned methodology required by the MPEP.

Applicants respectfully submit that there is sufficient disclosure which clearly sets forth that the claimed subject matter is described in such a way so as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. As such, Applicants respectfully request that the outstanding rejection be withdrawn.

**CLAIM REJECTIONS – 35 U.S.C. §112, SECOND PARAGRAPH**

The Examiner rejected claims 1-12, 31-40, 50 and 53-63 asserting the claims are indefinite as “It is not clear how hierarchical organization could be interpreted as continuous ... which are not continuous and have a particular size.” Applicants respectfully do not understand the Examiner’s rejections. The Examiner has failed to provide any indication of which claim elements the Examiner is asserting are indefinite. As such, Applicants cannot properly respond to the rejection.

Applicants respectfully direct the Examiner’s attention to the discussion set forth above regarding the drawing objections. If the Examiner maintains his rejection, the Examiner is requested to properly assert a *prima facie* rejection clearly identifying what claim elements the Examiner believes are indefinite, together with the proper support for his assertions in a new, non-final Official Action so that Applicants may have a proper opportunity to respond.

**ADDITIONAL COMMENTS**

The Examiner additionally asserts on page 5 of the outstanding Official Action, “Due to new matter situation and indefinite subject matter rejection on merits is not provided.” Applicants respectfully submit that the Examiner’s failure to consider the claims under 35 U.S.C. §102 and 35 U.S.C. §103 is wholly improper.

MPEP §707.07(g) clearly recites that a rejection on the grounds of new matter should be accompanied by a rejection by all other available grounds. As such, even if the outstanding rejections were proper, which Applicants clearly do not admit, the Examiner should have still have considered the patentability of the claims under 35 U.S.C. §102 and 35 U.S.C. §103.

Should the Examiner assert new grounds of rejection, the Examiner should do so in a new, non-final Official Action.

**CONCLUSION**

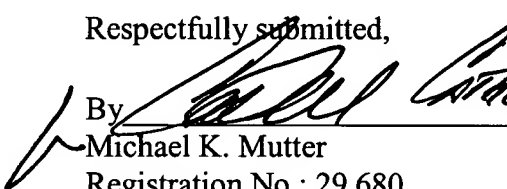
In view of the foregoing, Applicants respectfully submit that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Catherine M. Voisinnet (Reg. No. 52,327) at (703) 205-8000.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

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Respectfully submitted,

By  Catherine M. Voisinnet  
#52,327

Michael K. Mutter

Registration No.: 29,680

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants